

Remarks

Claims 1-13, 16-27, 33, 34, 36, 41-43, 48-53, 59, 66, and 124 are pending in the application following entry of this Amendment. Claims 1, 59, 66, and 124 have been amended. Claims 1, 59, and 124 are the only independent claims pending.

No new matter is added by the amendments and additions made herein. Support for the amendments to these claims is found in the specification as follows.

Each of claims 1, 59, and 124 was amended to recite characteristics of the "mineralized ash filler." The characteristics are recited at paragraphs [0027], [0091], and in Table 1 (on page 21) of the specification. These amendments do not alter the scope of these claims.

Claim 66 was amended simply to correct its antecedent basis in claim 59.

Rejections Pursuant to 35 U.S.C. § 112, First Paragraph

The Examiner rejects all claims pursuant to 35 U.S.C. § 112, first paragraph. In the Examiner's opinion, the specification does not adequately describe subject matter that indicates that the Applicants had possession of the claimed invention at the time the application was filed.

On pages 4 and 5 of the Office Action, the Examiner cites seven numbered reasons why the written description requirement is considered non-satisfied. For the sake of convenience and clarity, the Applicants respond individually to each of the seven reasons.

1) Lack of "basis" for the 20% content

The Examiner suggests that there is no basis on which 20% of the value listed in Table 1 can be calculated. However, the units ("TCLP filtrate concentration, milligrams per liter") are clearly specified in Table 1. A skilled artisan would immediately recognize that the "not more than 20% of the metal content...Table 1") recitation in paragraph [0027] (i.e., the definition of "mineralized ash filler") refers to the units used in Table 1. In order to clarify this issue, the Applicants have explicitly recited the values in each of the independent claims. The Applicants respectfully contend that no skilled artisan would fail to recognize what is claimed and that the Applicants were in possession of that subject matter at the time the application was filed.

2) Identification of "Standard Fly Ash"

The Examiner suggests that there is no "standard" fly ash. That fact is mooted, however, by the Applicants' explicit definition (in Table 1, as referenced in paragraph [0027]) of "Standard

Fly Ash." The Applicants respectfully contend that no skilled artisan would fail to recognize what the Applicants refer to as "Standard Fly Ash" and that the Applicants were in possession of the claimed subject matter at the time the application was filed.

3) Whether Arsenic is a "metal"

The Examiner questions whether arsenic is "usually" considered a metal. Regardless of whether arsenic is "usually" considered a metal or not, the Applicants' specification makes it clear (see Table 1 and paragraph [0056], for example) that arsenic is one of the elements by which mineralized ash filler is characterized. Nonetheless, in order to make the claims as clear as possible, the Applicants have amended each of the independent claims to recite allowable levels of "elements" (as that term is used in Table 1, for example), rather than "metals." The Applicants respectfully contend that a skilled artisan would immediately recognize (for example, from Table 1) that the Applicants were in possession of mineralized ash filler having the specified amount of arsenic, regardless of whether arsenic is considered a metal or not.

4) "Two commercialized entities"

The Examiner appears to believe that Table 1 refers to two commercialized mineralized fly ash preparations. This is incorrect.

Table 1 refers to a single commercialized mineralized fly ash preparation, separate samples of which were analyzed by two different commercial laboratories. The Applicants respectfully suggest that a skilled artisan would understand this, based not only on the text of paragraph [0091] and Table 1, but also in view of the text in paragraph [0098] of the specification. Thus, contrary to the Examiner's belief, the data presented in Table 1 demonstrate that the Applicants had possession of a mineralized ash filler having less than 20% of the elemental content of the "Standard Fly Ash" defined in Table 1 at the time the application was filed.

5) Identity of the Testing Procedure(s)

The Examiner asserts that the testing procedures described in Table 1 differ from those described in paragraph [0027]. They do not. The sample preparation and elemental analysis techniques are specified in paragraph [0091], of which the techniques recited in paragraph [0027] are one embodiment. A skilled artisan would recognize that there is no incongruity between the methods recited in paragraph [0027] and those described in Table 1 and paragraph [0091].

6) Identity of the Acid

The Examiner suggests that it is necessary to specify a particular acid in order to satisfy the written description requirement. In the Examiner's view, the identity of the acid can affect the "efficacy" of metal extraction. Acid extraction of metals is well known in the art, and a skilled artisan would not select a non-efficacious method of extracting a metal of interest. Furthermore, the specification does not require that the same acid be used for analysis of all metals. Skilled artisans in this field understand that multiple extractions, using the same acid or different acids, can be performed with individual aliquots of an ash sample. The Examiner cites no basis for the assertion that a skilled artisan would fail to understand how to perform the EPA standard methods described in the specification (e.g., see paragraph [0091] and EPA document SW-846) for any of the elements recited in the claims. Indeed, the fact that two commercial laboratories were able to analyze the mineralized ash filler sample described in Table 1 belies the Examiner's contention that skilled artisans are unable to perform such assays. The Examiner is respectfully invited either to submit evidence that a skilled artisan would be unable to extract metals from an ash sample or to reconsider and withdraw this portion of the rejection.

7) The Meaning of "any individual metal"

The Examiner suggests that the meaning of the term "any individual metal listed herein in Table 1" is unclear.

Taken in the abstract, the term may be unclear. However, in the context of the specification, the term is clear. For example, paragraph [0019] recites that, "*Mineralization refers to removal from an ash preparation of metal atoms and compounds that are not part of a relatively inert mineral complex.*" This issue is believed to be moot in view of the explicit recitation in the amended claims of elemental limits.

In view of the foregoing comments, the Applicants respectfully contend that a skilled artisan would conclude from careful review of the specification that the Applicants were in possession of the claimed compositions and methods at the time the application was filed. For this reason, the Applicants respectfully contend that the Examiner's written description-based rejection of all pending claims pursuant to 35 U.S.C. § 112, first paragraph, is not applicable to the pending claims, as amended. Reconsideration and withdrawal of this rejection are requested.

Rejections Pursuant to 35 U.S.C. § 112, Second Paragraph

Claim 66 was rejected pursuant to 35 U.S.C. § 112, second paragraph, for lack of antecedent basis for the word "polymer." This has been corrected by substitution of "plastic" (as recited in claim 59, from which claim 66 depends) in place of "polymer," and the rejection of claim 66 is believed to be moot for that reason.

The Examiner has also rejected all pending claims on the ground that the purported failure to comply with the written description requirement of 35 U.S.C. § 112, first paragraph, renders the claims indefinite. The comments made in the section of this Amendment pertaining to the written description rejection apply equally here and are incorporated by reference, rather than being copied and pasted here. The Applicants respectfully contend that the claims, as amended, recite compositions and methods that are not only adequately described in the specification, but are also definite within the meaning of 35 U.S.C. § 112, second paragraph. A skilled artisan would have no difficulty understanding the metes and bounds of the invention recited in the claims as amended, and the Examiner's rejection of all pending claims pursuant to 35 U.S.C. § 112, second paragraph, is believed to be overcome for that reason. Reconsideration and withdrawal of this rejection are respectfully requested

Summary

The Applicant respectfully contends that each of claims 1-13, 16-27, 33, 34, 36, 41-43, 48-53, 59, 66, and 124 is in condition for allowance. Consideration of each of the claims and issuance of a Notice of Allowance are requested at the earliest possible time.

Respectfully submitted,

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